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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,518	11/29/2001	Katsuhiro Doi	450100-03654	3535

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NEW YORK, NY 10151

EXAMINER

LUK, EMMANUEL S

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,518

Applicant(s)

DOI ET AL.

Examiner

Emmanuel S. Luk

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-4, drawn to a molding die apparatus, classified in class 425, subclass 546.
- II. Claims 5 and 6, drawn to a method of obtaining a molded product, classified in class 264, subclass 328.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice.

The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materiall different apparatus, such as one where the channel to the vacuum tank is formed by the closing of the set of dies, but rather it is a separate part of the apparatus.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Will Frommer, by Examiner Fontaine, on 29 October 2002, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-4. Affirmation of this election must

Art Unit: 1722

be made by applicant in replying to this Office action. Claims 5 and 6 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Osada et al (5603879).

Osada teaches the claimed apparatus having a cavity (20) formed by dies (7, 8), the vacuum apparatus (45) is disposed in proximity to the cavity (Fig. 1) and communicates with a circumferential portion of the cavity, the vacuum tank (45) also having a valve (47, 48) for controlling the open and close of passage between the vacuum channel and the exhaustion channel (39).

Art Unit: 1722

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1722

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osada et al (5603879).

Osada teaches the a cavity (20) formed by dies (7, 8), the vacuum apparatus (45) is disposed in proximity to the cavity (Fig. 1) and communicates with a circumferential portion of the cavity, the vacuum tank (45) also having a valve (47, 48) for controlling the open and close of passage between the vacuum channel and the exhaustion channel (39).

Osada fails to teach the tank being at least a larger than a total volume capacity of the cavity plus said exhaustion channel.

In regards to the size of the vacuum tank, it would have been obvious to one of ordinary skill in the art to change the size of the tank for the desired vacuum effect on the cavity. Thus, a larger tank size for achieving a complete vacuum of the cavity.

12. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagasaka et al (5628944) in view of Osada et al (5603879).

Nagasaka teaches the claimed apparatus having a cavity (5) formed by dies (2, 3), the vacuum apparatus (18) is disposed in proximity to the cavity (Fig. 1) and communicates with a circumferential portion of the cavity (7), the vacuum pump (18) also having a valve (17) for controlling the open and close of passage between the vacuum channel and the exhaustion channel (15).

Nagasaka fails to teach a vacuum tank and the tank being at least a larger than a total volume capacity of the cavity plus said exhaustion channel.

Art Unit: 1722

Osada teaches the a cavity (20) formed by dies (7, 8), the vacuum apparatus (45) is disposed in proximity to the cavity (Fig. 1) and communicates with a circumferential portion of the cavity, the vacuum tank (45) also having a valve (47, 48) for controlling the open and close of passage between the vacuum channel and the exhaustion channel (39).

In regards to the size of the vacuum tank, it would have been obvious to one of ordinary skill in the art to change the size of the tank for the desired vacuum effect on the cavity. Thus, a larger tank size for achieving a complete vacuum of the cavity.

It would have been obvious to one of ordinary skill in the art to modify Nagasaka with a vacuum tank as taught by Osada because it allows for the air to be pumped into a tank thereby allowing for instantaneous evacuation.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ibar, Megleo, Mueller et al and Tisack et al.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel S. Luk whose telephone number is (703) 305-1558. The examiner can normally be reached on Monday through Friday 8 to 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on (703) 308-0457.

Art Unit: 1722

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

E.L.
August 6, 2003


W. L. WALKER
SUPERVISORY PATENT EXAMINER
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